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Supreme Court of the United States

OCTOBER TERM, 1905.

No. 187.

A. LEECHEN & SONS ROPE COMPANY,
Appellant,
vs.
BRODERICK & BASCOM ROPE COMPANY,
Appellee.

BRIEF FOR APPELLANT

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PRESS OF W. F. ROBERTS CO., WASHINGTON

Supreme Court of the United States

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A. LESCHEN & SONS ROPE COMPANY,
Appellant,
vs.
BRODERICK & BASCOM ROPE COMPANY,
Appellee.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

STATEMENT OF CASE.

This is a suit in equity brought by A. L. Leschen & Sons Rope Company, a Missouri corporation, against Broderick & Bascom Rope Company, another Missouri corporation, for infringement of a Trade Mark for Wire Rope, registered under the Act of Congress of March 3, 1881.

The bill of complaint was filed May 8, 1903, in the Circuit Court of the United States for the Eastern Division of the Eastern District of Missouri (p. 2). The defendant demurred on the ground that the trade mark set up in the bill was not a lawful and valid trade mark (p. 8). The demurrer was allowed (p. 9) and, the complainant declining to plead further, the bill was dismissed (p. 10). From the decree of dismissal an appeal was taken to the United States Circuit Court of Ap-

peals for the Eighth Circuit (p. 10) and the latter court, on December 24, 1904, affirmed the decree of the circuit court (p. 23).

From the decree of the Circuit Court of Appeals the present appeal was duly taken (p. 27) and the cause is now in this court for review.

Assignment of Errors.

Although various assignments of error appear in the record (p. 24) they all have for their object the bringing up for review by this court the fundamental, underlying question of the validity of the trade mark set out in the complainant's bill of complaint.

Argument.

I. Attempts made to define what a trade mark is have usually been open to the criticism of narrowness. Browne on Trade Marks, 2nd Edition, p. 98, Sec. 85, has this to say:

> "The French have probably given this subject as keen and thoughtful study as any jurists in the world; and yet in the report of the Commission to examine the project which crystallized into their legislative act of the 23rd of June 1857, it is said:
>
> 'In what do marks consist? The plan of the law, avoiding the peril of a definition and leaving to doctrine and to jurisprudence the task of defining, has remained mute in this respect.'

The Council of State concurred in this idea of the impolicy of attempting an exact enunciation of the elements which constitute this thing, and said:

> 'The mark is any sign by means of which commerce distinguishes the products of one's manufacture, or the objects of his commerce.' "

In Elgin Watch Co. v. Illinois Watch Co. 179, U. S. 665, which was a case involving a trade mark registered under the very Act of March 3, 1881, under which the trade mark here in suit was registered, the present learned Chief Justice, speaking for this Court, said:—

> "Trade marks are not defined by the Act, which assumes their existence and ownership, and provides for a verified declaration by applicants for registration, that they have the exclusive right to the particular trade mark sought to be registered.
>
> "The term has been in use from a very early date, and, generally speaking, means a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others."

This definition, because of its breadth and scope and inclusiveness, seems to leave nothing to be desired, and we adopt it as the most satisfying of the scores to be found in the cases and in the text books.

II. Ever since its incorporation in the year 1886, the complainant company has been engaged in the manufacture and sale of wire ropes or cables. It is, therefore, a "particular manufacturer" as well "as a particular merchant," within the learned Chief Justice's definition.

In the year 1888, or about eighteen years ago, the Complainant adopted for its use and applied to its highest and best grade of wire rope or, in other words, to its manufactured "products," its "vendible commodities," so that said "products" and "vendible commodities might be distinguished from those of others" and bear a "distinctive mark of authenticity," a streak or stripe of contrasting color, usually red, laid upon one of the strands of each rope made by it.

As all the strands of a wire rope run spirally about its central core the effect of thus laying a stripe of color upon one individual strand was to give a definite, characteristic appearance to that particular strand and to cause it, by contrast with its fellows of different appearance, to stand out prominently as a distinctive spiral streak, which served, as a trade mark, readily identifying and distinguishing complainant's wire rope from the wire rope put out by all other manufacturers.

The spiral line of contrasting color thus applied was and is intended as and for a trade mark and for no other purpose. It serves no other purpose. It adds nothing to the strength or durability of the rope. It performs no mechanical function whatever. Nor is it applied for its beauty or aesthetical effect. It is essentially fugitive in character being worn off in the use of the rope.

The expense of applying this characteristic mark to the rope and of advertising it as complainant's trade mark, is considerable, yet so thoroughly does the mark distinguish complainants product from that of others that this expense is fully justified.

The bill avers that upwards of eight million feet of wire rope marked and identified in this way have been made and sold by complainant (p. 3); that such marking has come to identify complainant's rope throughout the United States and in foreign countries; and that all, save the defendant company, have recognized complainant's right to said mark and have acquiesced in complainant's rights therein and thereto. (p.4)

The demurrer, of course, admits all this to be true.

III. The next question, and apparently the crucial one, from the standpoint of the courts below, is: Were

the steps taken by complainant to register its mark under the Act of March 3, 1881, sufficient to secure to it the right to invoke the aid of the Federal Courts in the vindication of its mark as against infringers of it?

Let it be remembered, that registration under the Act of Congress creates no right of trade mark whatever. It simply confers the privilege of suing in the Federal Courts in case the registered mark is infringed by another engaged in commerce with foreign nations or Indian tribes.

Again referring to the opinion of the learned Chief Justice, in the Elgin case, (supra):

> "Trademarks are not defined by the Act, *which assumes their existence,* and ownership, and provides for a verified declaration by applicants for registration, that they have the exclusive right to the particular trade mark sought to be registered."

No right of trade mark being then created by the Act, the precise point to be determined in this particular case is simply this: Did the complainant in asking for registration under the Act of Congress sufficiently identify its mark, already then in existence and in use by it, so as to enable the Federal Courts to determine what it is and to enforce it?

IV. Sec. 1 of the Act provides that "owners of trade marks" may obtain registration by causing to be recorded in the Patent Office, among other things, "a description of the trade mark itself, *facsimiles* thereof, and a statement of the mode in which the same is applied and affixed to the goods."

Of course, the purpose of all this is identification. In determining whether complainant's mark is identified in the certificate of registration this court will care-

fully examine the whole document and will not be astute to give an interpretation that will result in a forfeiture of any of complainant's rights.

The statute under which the registration was made is a remedial one and will be beneficently construed to preserve the right and advance the remedy.

In the "statement" of the certificate the solicitor for the registrant began as follows: (p. 7)

> "The trade mark consists of a red or other distinctively-colored streak applied to or woven in a wire rope. The color of the streak may be varied at will, so long as it is distinctive from the color and body of the rope."

This, standing alone, was rather indefinite and left the questions: What kind of a streak? What does it look like? unanswered.

The draftsman of the document then made another trial (p. 7)

> "The essential feature of the trade mark is a streak of distinctive color produced or applied to a wire rope.
>
> "This mark is usually applied by painting one strand of the wire rope a distinctive color, usually red."

This was better. An idea of the appearance sought to be described begins to dawn upon one reading this statement. The mark is to be "applied by painting one strand of the wire rope a distinctive color, usually red." This, of course, assumes a knowledge on the part of the reader of the appearance of a wire rope, with its spirally twisted strands; but, with that assumption, it clearly indicates that one of the spiral strands is to be painted a distinctive color, preferably red, so as to give

the appearance of a spiral of distinctive contrasting color applied to the rope.

The draftsman of the statement had the pictorial representation or *facsimile*, of the mark before him which now appears as a part of the certificate (opp. p. 7), and assumed, naturally, that what he was writing would be read in connection therewith. So read, the meaning of the language is perfectly plain, for the distinctively spiral line of contrasting color applied to one strand of the rope is as clearly indicated, even by the black and white drawing of the *facsimile*, as though there were written on the dark strand "This is the streak of contrasting color applied to one strand of the rope, mentioned in the accompanying statement, which constitutes the trade mark."

But more than this. In the sworn declaration which accompanied the statement the registrant made oath: (p. 8)

> "that the *description and facsimile* presented for record truly represent the trade mark sought to be registered."

It will be noted that the declaration was *not* that the *description*, alone, truly represented the trade mark sought to be registered, but that "*the description and facsimile*" both taken together, "*truly represent*" such mark. This is the kind of declaration required by Sec. 2 of the act which says the applicant must declare "that the description and facsimiles presented for registry truly represent the mark sought to be registered."

The act, in Sec. 4, further provides for the certification of the *trade mark* in addition to the statements and declarations filed therewith.

Giving, then, all parts of the certificate due consideration, the drawing or *facsimile*, as well as the descrip-

tion, it seems clear that the trade mark identified by the certificate is indubitably and indisputably the same mark as that set forth in the bill of complaint as the mark that complainant has so extensively used and which has come to be so widely recognized and acquiesced in as identifying its wire rope from that produced by other manufacturers.

Certainly, no fair minded person examining the certificate, as a whole, both description and *facsimile*, with the honest intention and desire of ascertaining what the real trade mark was that applicant had adopted and sought to disclose would fail to see that it was a spiral streak of distinctive contrasting color applied to a wire rope, and that the usual mode of applying said spiral streak was to paint one and one only, of the spiral strands of the rope itself.

If, therefore, it be conceded, as we think it must be, that complainant's trade mark as actually used is sufficiently identified by the certificate of registration, it follows that complainants registration was valid and should be upheld and the protection of the Federal Courts should not be denied it.

V. The courts below, while apparently of the opinion that color could not be seriously considered as entering into the composition of a trade mark, nevertheless, with some inconsistency, criticised the sufficiency of complainant's registration because the statement declared that red was the color "usually" employed for the spiral streak in complainant's trade mark, thereby implying that colors, other than red, might be used, and held that, because of this alleged indefiniteness, the registration was invalid.

In reply, we submit that complainants trade mark

is, at least, good for the color, red, specifically designated as the one usually employed.

Whether or not a spiral streak of some other color and differing from compainants *only* in color would be substantially the same as complainant's red spiral streak is a question of fact that may never arise. It certainly is not put in issue by the demurrer.

If in the registration of a trade mark for cotton goods, consisting of the figure of an anchor, the applicant should say, in his statement, that his mark consisted of the picture of an anchor, which was *usually* printed in red color upon his goods, or if, in the registration of a trade mark for soap, consisting of the word Sapolio, the applicant should say that his mark consisted of the word Sapolio, which he usually applied in form of red letters to the wrappers containing his soap, and it should appear, in a suit brought under the first named registration, that an infringer had used the same identical figure of an anchor printed in *blue*, or, in a suit brought under the other registration that the infringer had used on his wrappers the word Sapolio printed in *blue*, would this court, or any court, hold that there had been no infringement of the vital and substantial feature of the mark. Surely not. So, in the case at bar, should it ultimately appear that the defendant used the same identical device of a distinctive spiral streak of contrasting color applied to one of the spiral strands of its wire rope, but instead of a red streak, employed a blue "streak," and by reason of the employment of such blue streak succeeded in confusing the public and in diverting and running away with complainant's trade, would this court hold that it had not infringed? How swift would defendant's punishment be in such a case.

But, as we have said, the question of whether or not one color is the equivalent of another has not yet arisen in this case. Complainant's mark must be sustained as good, and its registration as valid, if said mark shall be found good as covering the spiral streak of the specific contrasting color which it has used as a trade mark.

VI. The criticism that complainant's trade mark is *descriptive* can hardly be dealt with with patience.

A descriptive trade mark is one that describes the article or the quality of the article to which it is applied, or the place where the article is produced, as, for instance, "Iron Bitters" (Brown Chemical Co. v. Meyer, 139 U. S. 540); "Goodyear Rubber" (Goodyear India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. 128 U. S. 598) "Lackawanna Coal" (Canal Co. v. Clark 13 Wall. 311); "Elgin Watch Cases" (Elgin Nat. Watch Co. v. Illinois Watch Case Co. 179 U. S. 665).

If a trade mark is descriptive because it is described in the application for Federal registration of it, as required by the statute, then the mark in this case is descriptive; but not otherwise.

VII. The courts below also seem to have conceived the notion that because complainant has applied its distinctive streak of contrasting color to a spiral strand of its rope and to such strand throughout the length of the rope, it has thereby taken the mark out of the category of legitimate trade marks.

Nothing, we submit, could be further from the truth. The application of the streak of color to a strand of the rope was only incidental. It might be, for convenience, applied in that way, as shown in Plate I, at the end of this brief, or to parts of two adjacent strands, as shown

on Plate II, or reversely, across all the strands, as shown in Plate III. But, in all these variations, the distinctive character of the mark is preserved. It is still a spiral streak of contrasting color and would be recognized, anywhere, as complaintant's distinctive mark.

As to the running of the spiral streak of color throughout the entire length of the rope, it can hardly be seriously contended that a trade mark which is a good one when applied to the first few feet of a coil of rope is not equally good when applied to each and every segregable part of the whole coil. If complaintant's spiral streak of contrasting color were applied to but one end of its coils of rope, a dishonest merchant, known to deal in complaintant's goods, might palm off an indefinite amount of rope of inferior quality upon an unsuspecting purchaser by simply representing that the article sold was part of a coil of complaintant's rope from which the trade-mark-end had been cut; but by applying the trade mark to every part of the coil, every segregated inch points to its origin, to complainant as the manufacturer, and the purchaser is enabled to see with his own eyes that he is getting just what he de sires and pays for.

Another example of the continuous application of a trade mark to an article produced in lengths, is afford-ed by the well known water-marking of paper, where the paper, as it is produced in continuous lengths, re-ceives the water mark, and every sheet cut from the length shows the mark, or some portion of it, the mark-ing thus becoming the symbol of authenticity.

VIII. The bill tells us that the identical mark cover-ed by complainant's registration was claimed to belong to the defendant in this case; that the defendant made an application for registration of the same in the Pat-

ent Office; that an interference was declared between complainant and defendant by the Commissioner of Patents under the statute; and that Complainant's priority of adoption and use was decreed, first by the Examiner and then, finally by the commissioner of Patents on appeal.

The Act of March 3, 1881, says: (See 3)

> "In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable the practice of courts of equity of the United States in analogous cases."

The Act, therefore, lodges a part of the judicial power of the Government in the Commissioner of Patents.

> Bernardin v. Seymour, 10 App. D. C. 294.
> U. S. v. Duell, 172 U. S. 576.

The judgment of the Commissioner of Patents, acting as a judicial officer, in favor of complainant, on the question of priority of adoption, necessarily involved a decision of the validity of the trade mark in question, for he could not find priority in respect of an invalid trade mark any more than he could find priority in respect of an *unpatentable* invention.

> Hill v. Wooster, 132 U. S. 693.

The Commissioner, having therefore, in a judicial proceeding authorized by Statute, decided the trade mark here in dispute to be a lawful and valid trade mark and to belong to the complainant, the defendant herein, in this judicial proceeding, between the same par-

ties, in respect of the same subject matter, and under the same statute, cannot now be heard to question the validity of that mark. The matter has become *res adjudicata.*

Aurora City v. West, 7 Wall. 82
Last Chance Min. Co. v. Tyler Min. Co. 157 U. S. 683.
Hanford v. Westcott, Fed. Case. No. 6022.

IX. The decrees of the courts below should be reversed, with directions to reinstate complainant's bill of complaint and to order defendant to answer the same.

HERVEY S. KNIGHT,
MELVILLE CHURCH.
Counsel for Appellant.

Jan. 19, 1906.
Washington, D. C.,

Plate I.

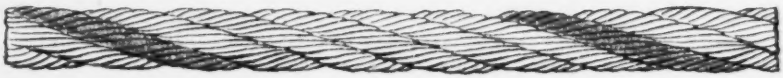


PLATE II.

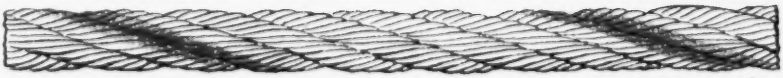
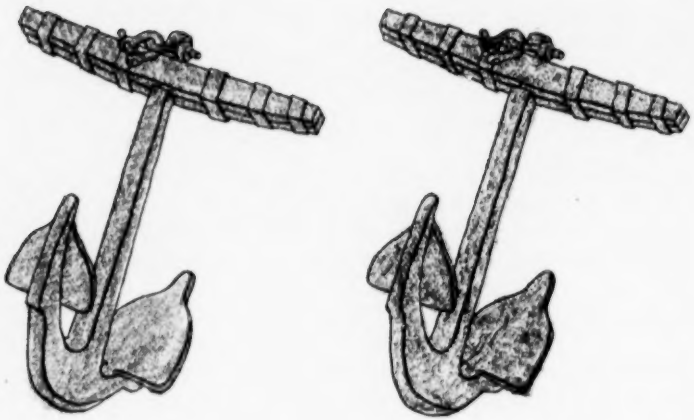


PLATE III.

PLATE IV.



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